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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,908	01/25/2002	Motonori Sano	03560.002989	4801
5514	7590	01/10/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			TAYLOR, BARRY W	
		ART UNIT	PAPER NUMBER	
		2643		

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/054,908	SANO, MOTONORI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Barry W. Taylor	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 September 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-33 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____.  | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1-8, 11-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byers (5,570,417) in view of Wulkan et al (5,862,203 hereinafter Wulkan).

Regarding claims 1, 11 and 13. Byers teaches a system and method that provides usage discounts and the like to subscribers (abstract). Byers teaches a tally is kept for all calls made by customers so that discounts (i.e. "additional service") may be provided to customers (col. 3 line 3 – col. 4 line 48, col. 4 line 63 – col. 5 line 36).

Byers does not show accumulating a communication time of each call from a calling party the user receives through the communication service of the communication company.

Wulkan accumulates the time and/or amount of each call so volume discounts can be given to customers (columns 1-3, col. 5 lines 1-5, col. 10 lines 28-47, col. 17 lines 5-35). For example, higher discount for longer calls or small discount for short calls---col. 17 line 27).

It would have been obvious for any one of ordinary skill in the art at the time of the invention to utilize the teachings of Wulkan into the teachings of Byers in order to

offer different prices for different levels of consumption as disclosed by Wulkan (col. 17 line 27).

Regarding claims 2, 14, 18 and 22. Wulkan teaches the additional service is a discount (see column 17 wherein different prices for different levels of consumption.

Regarding claims 3 and 19. Wulkan teaches the additional service in accordance with communication time and amount of communication (col. 17 lines 5-35).

Regarding claim 4. Byers teaches discounts in conjunction with time of day (abstract).

Regarding claim 5. Wulkan teaches company provides free day dialing while charging at other times (column 17).

Regarding 6. Byers teaches that if calling party is a subscriber, then give discount but if the calling party not a subscriber then select long distance carrier in a normal manner (columns 3-4).

Regarding claims 7 and 12. Byers teaches a system and method that provides usage discounts and the like to subscribers (abstract). Byers teaches a tally is kept for all calls made by customers so that discounts (i.e. "additional service") may be provided to customers (col. 3 line 3 – col. 4 line 48, col. 4 line 63 – col. 5 line 36).

Byers does not show accumulating a communication time of each call from a calling party the user receives through the communication service of the communication company.

Wulkan accumulates the time and/or amount of each call so volume discounts can be given to customers (columns 1-3, col. 5 lines 1-5, col. 10 lines 28-47, col. 17

lines 5-35). For example, higher discount for longer calls or small discount for short calls---col. 17 line 27).

It would have been obvious for any one of ordinary skill in the art at the time of the invention to utilize the teachings of Wulkan into the teachings of Byers in order to offer different prices for different levels of consumption as disclosed by Wulkan (col. 17 line 27).

Regarding claim 8. Wulkan teaches additional service is reduced rate (column 17).

Regarding claims 15-16. Byers teaches a system and method that provides usage discounts and the like to subscribers (abstract). Byers teaches a tally is kept for all calls made by customers so that discounts (i.e. "additional service") may be provided to customers (col. 3 line 3 – col. 4 line 48, col. 4 line 63 – col. 5 line 36). Byers teaches different exchanges and different service providers (col. 6 lines 10-19).

Byers does not show accumulating a communication time of each call from a calling party the user receives through the communication service of the communication company.

Wulkan accumulates the time and/or amount of each call so volume discounts can be given to customers (columns 1-3, col. 5 lines 1-5, col. 10 lines 28-47, col. 17 lines 5-35). For example, higher discount for longer calls or small discount for short calls---col. 17 line 27). Wulkan also teaches plurality of exchanges and plurality of service providers (see all especially figure 1).

It would have been obvious for any one of ordinary skill in the art at the time of the invention to utilize the teachings of Wulkan into the teachings of Byers in order to offer different prices for different levels of consumption as disclosed by Wulkan (col. 17 line 27).

Regarding claim 17. Wulkan teaches subscribers call 1-800 number (column 17).

2. Claims 9-10, 20-21 and 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byers (5,570,417) in view of Wulkan et al (5,862,203 hereinafter Wulkan) further in view of Dahm et al (6,597,903 hereinafter Dahm).

Regarding claims 9-10. Byers teaches a system and method that provides usage discounts and the like to subscribers (abstract). Byers teaches a tally is kept for all calls made by customers so that discounts (i.e. "additional service") may be provided to customers (col. 3 line 3 – col. 4 line 48, col. 4 line 63 – col. 5 line 36).

Byers does not show accumulating a communication time of each call from a calling party the user receives through the communication service of the communication company.

Wulkan accumulates the time and/or amount of each call so volume discounts can be given to customers (columns 1-3, col. 5 lines 1-5, col. 10 lines 28-47, col. 17 lines 5-35). For example, higher discount for longer calls or small discount for short calls---col. 17 line 27).

It would have been obvious for any one of ordinary skill in the art at the time of the invention to utilize the teachings of Wulkan into the teachings of Byers in order to offer different prices for different levels of consumption as disclosed by Wulkan (col. 17 line 27).

Byers in view of Wulkan fail to show the user being notified.

Dahm teaches using customized message to be send to customer to offer incentives in exchange for agreeing to a contract with a longer term (columns 1-2, figures 5-6, columns 11 – 15) when accumulation reaches a predetermined amount.

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Dahm into the teachings of Byers and Wulkan in order to offer incentives to subscribers so providers can keep customers longer.

Regarding claims 20-21. Wulkan teaches accumulating the time and/or amount of each call so volume discounts can be given to customers (columns 1-3, col. 5 lines 1-5, col. 10 lines 28-47, col. 17 lines 5-35). For example, higher discount for longer calls or small discount for short calls---col. 17 line 27).

Regarding claims 23, 25, 27, 29, 31 and 33. Byers in view of Wulkan fail to show radio line.

Dahm teaches using customized message to be send to customer to offer incentives in exchange for agreeing to a contract with a longer term (columns 1-2, figures 5-6, columns 11 – 15) when accumulation reaches a predetermined amount. Dahm further radio line (see 102, 108 figure 1).

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It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Dahm into the teachings of Byers and Wulkan in order to offer incentives to subscribers so providers can keep customers longer.

Regarding claims 24, 26, 28, 30 and 32. Byers teaches different exchanges and different service providers (col. 6 lines 10-19). Wulkan also teaches plurality of exchanges and plurality of service providers (see all especially figure 1).

***Response to Arguments***

3. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W. Taylor, telephone number (571) 272-7509, who is available Monday-Friday, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached at (571) 272-7499. The central facsimile phone number for this group is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (571) 272-2600, the 2600 Customer Service telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Centralized Delivery Policy:** For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the central fax number (571-273-8300).



BARRY TAYLOR  
PRIMARY EXAMINER